

REMARKS

Formal drawings and amendments to the specification and abstract were previously submitted with the previous response acknowledged in this office action as being filed January 23, 2004. No reference is made herein and it is assumed the above are in order.

Claim Rejections

Claims 1, 4-8, and 14-18 were previously cancelled.

Claims 3, 2, 9-13 and 19-32 are pending. Claim 3 is the sole independent claim and all others depend therefrom, including claim 2.

The Examiner identified a §112 indefiniteness defect in claims 13 and 30.

In claim 13, Examiner objected to the terminology "such as". Claim 13 has been amended as suggested by the Examiner to replace "methods such as" with – at least one of –.

In claim 30 Examiner objected to the terminology "deemed worthy". As suggested by the Examiner, claim 30 has been amended, as supported by the specification as filed at page 14, line 25 [0051], to replace the language "deemed worthy" so as to more clearly set forth that archived "deemed worthy" is all IP archived at a permanent IP Address or PIPA at a permanent IP domain or PIPD.

Claims 3, 2, 10-13 and 19-32 - Rejection under 35 USC 103(a) – Obviousness

Examiner has rejected claims 3, 2, 10-13 and 19-32 as being obvious over Watanabe et al. (US 6,157,947, hereafter "Watanabe") in view of Wilkinson (US 2001/0034695, hereafter Wilkinson).

Watanabe is a new cited reference. Wilkinson was raised in Applicant's previous response.

Claim 3 has been amended to further clarify the principles of the separation of the source and management of revenue from "user fee based access" and archival permanence through "enduring funding".

As set forth below, it is believed that amended claim 3 is allowable and therefore claims 2, 9-13 and 19-32 are also allowable as being dependent from allowable claim 3.

SERIAL NO. 09/864,038

8

Att'y Docket: 2157-001 (old)

Claim 3

Examiner rejected claim 3 as being obvious over Watanabe in view of Wilkinson.

As stated set forth in this office action:

- at Office Action Page 3, paragraph 4 (OA P.3, §4), Examiner states *"Watanabe does not specifically teach user fee or endowment fund."*

Watanabe teaches archiving of IP for use by users within an organization, albeit at a variety of locations, some of which can be accessed through an electronic network. Watanabe is concerned with notification of the users of the existence of IP and providing a mechanism for locating and retrieving the IP. There is no contemplation of how the costs of such a system would be maintained so as to preserve the IP.

The Examiner suggests Wilkinson provides the missing elements of Watanabe as follows:

- At OA P.3, §5, in reading back amended claim 3, the Examiner states *"Wilkinson teaches 'enabling a user fee based on access to the archived intellectual property' and refers to Wilkinson [0023],[0025] and [0035]"*
- At OA P.4, §1, in reading back amended claim 3, the Examiner states *"Wilkinson teaches 'funding an endowment trust from archival fees ... ' and again refers to Wilkinson [0023],[0025] and [0035]"*

As Watanabe is directed to archival of IP internal to an organization, Watanabe would not contemplate, nor would Watanabe be directed, to seek a system for charging fees for access. Further, or alternatively, as the IP of Watanabe's organization is of interest to, and for access only by, the organization there is no need nor any direction for Watanabe to seek means, such as an endowment, for maintenance of the system to assure continued availability of the IP should the users fail to pay fees, or in Watanabe's case, lose interest in the IP entirely.

Simply, Watanabe would not be directed to seek either a user fee based access, nor would Watanabe be directed to fund an endowment trust.

Turning more specifically to Wilkinson, Wilkinson teaches, and as is emphasized at [0023], [0024], [0025], and at [0035]:

SERIAL NO. 09/864,038

9

Atty Docket: 2157-001 (old)

- That an IP market can be established, much as the stock market exists.

The relevant portion of [0024] reads:

"The IP market of this invention provides an independent valuation/appraisal method and service that periodically calculates and tracks the desired value of a particular intellectual property asset, much in the same way that stock markets set the market capitalization of corporations."

- That the emphasis is on the regulation and tracking of the value of IP Assets or the business entities holding those assets.

The relevant portion of [0035] reads:

"In this way, financial instruments related to IP assets or entities holding IP assets may be tracked against the performance of other IP assets or entities holding IP assets."

- That the regulation of this IP Market needs to be funded.

The relevant portion of [0023] reads:

"The IP market may be regulated transaction fees or listing fees, to fund the regulatory process."

- That the value of an IP asset or the market value of the owner of the IP is monitored. An owner can include a variety of business entities including a trust.

The relevant portion of [0025] reads:

"the valuation method of using IP market may comprise computer the value in part or in whole of any business entity for any purpose by taking into account the tangible market value of IP assets. A business entity may be any business organization of part thereof, such as a partnership, fund, corporation, trust, foundation endowment, sole proprietorship, association,... and the like." The purpose of determining the value may include for use as a basis for any financial transaction or for any business or financial purpose"

As shown above, Wilkinson does not teach a user fee based access to archived IP. Instead:

- Wilkinson tracks financial values (a dynamic event) and it is counterintuitive to archive a value in a market trading in dynamic values. No archival of IP is contemplated.
- Wilkinson does contemplate charging fees which are specifically to be used to regulate this IP Market of financial values, including enforcing rules. Wilkinson does not contemplate the entities paying fees to access the IP.

SERIAL NO. 09/864,038

10

Atty Docket: 2157-001 (old)

The entities are participating in speculation and financing in the value of IP. The fees are for accessing a service not to access IP or any archived materials for that matter.

- Wilkinson merely teaches that it is important, when regulating an activity or service provided for the benefit of users, to fund the activity through fees paid by those users.

Simply, Wilkinson does not contemplate archival of IP. Wilkinson is not concerned about the funding of, the maintenance of or the management of access to IP information. Wilkinson is focused on the financial value of IP or entities holding IP. Wilkinson's narrow concept of charging fees to fund the regulation of a service is not related to the archiving of IP.

Regardless, whether or not user's fees are charged, also as shown above, Wilkinson does not teach funding an endowment trust from archival fees.

- Wilkinson acknowledges that the value of an IP is based on the IP Asset itself or the business entity holding the IP Asset.
- Business entities contemplated by Wilkinson include a variety of legal entities including business such as trusts and endowments The objectives of such business entities are not disclosed.
- Wilkinson is not concerned with the assurance of the continued availability of the IP Asset, only its value, or the value of the entity holding IP.

A business entity is not equivalent to an endowment fund for assuring the archival of IP. For example, a business entity as a "trust" or an "endowment" could comprise an organization (as suggested by Wilkinson), which could be a non-profit organization, and would then potentially also comprise an endowment fund for furthering the principles of the non-profit organization. This business entity may also have IP Assets having a value under Wilkinson's IP Market paradigm. The activities or financial value of a business entity owing IP are distinct and different in character and function from Applicant's endowment fund, funded from archival fees, which is directed to the assurance of the continued availability of archived IP.

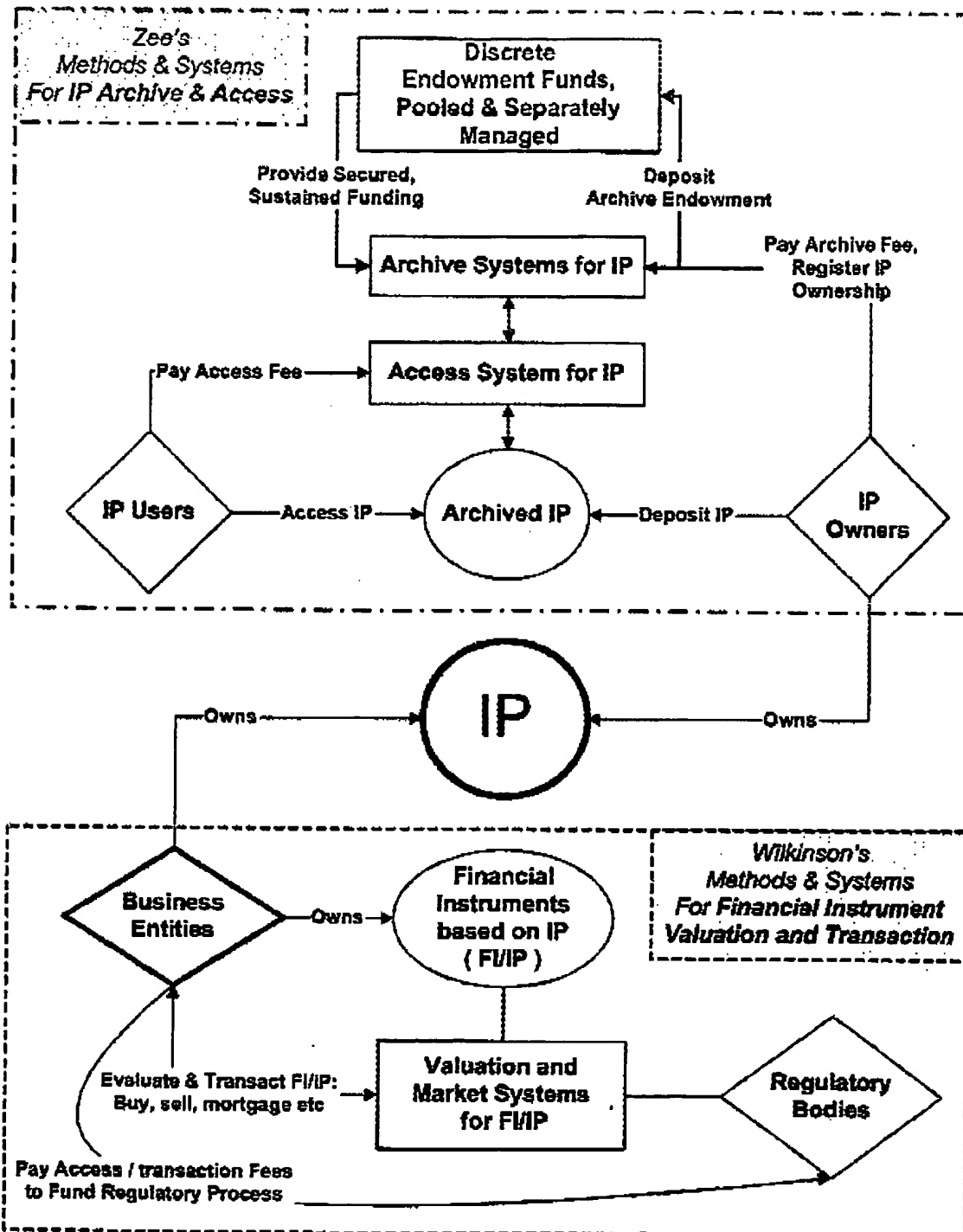
Included herein and as follows is an Example Flowchart (provided as remarks and not for inclusion with, nor to be deemed an amendment to, the specification) further illustrates the distinctions between the Applicant and Wilkinson.

For simplicity, the Flowchart highlights the differences through a preferred embodiment, more particularly in the:

-**Purposes:** Applicant's 'IP Archive & Access' versus 'Wilkinson's 'Financial Instruments Valuation and Transactions';

-**Functions:** Applicant's 'provide secured, sustained archive funding' versus Wilkinson's 'evaluate and transact financial instruments based on IP'; and

-**Fees:** Applicant's 'fee to fund archival endowment fund' versus Wilkinson's fee 'to fund the regulatory process' (Wilkinson[0023]).



SERIAL NO. 09/864,038

12

Atty Docket: 2157-001 (old)

The whole point is that Applicant is not aware of any reference which addresses specifically the challenges of managing a system for archiving IP for assured future access, in which the archival operation for the IP is being funded, not from the ongoing user fees but from a discrete archival fee separately managed as endowment fund.

In short, Wilkinson is not archiving IP. Wilkinson is funding with fees the regulation of an IP Market of the financial value of IP Assets, not the access to archived IP. Wilkinson does not contemplate assuring the continued availability of IP. Wilkinson is concerned only of the value of IP Assets which may include the value of a business entity which happens to own IP.

There is no motivation for a reader to combined Wilkinson and Watanabe. A marketplace for the trading in IP Assets cannot direct the reader to fund access (through fees), nor a need to received an archival fee to assure continued availability of the archived IP.

Claim 3 should be in condition for allowance. Accordingly, claims 2, 9-13 and 19-32 should also be in condition for allowance as being dependent upon an allowable claim.

While Watanabe and Wilkinson do not teach all of the elements of claim 3, nor in combination, and claims dependent thereon should also be allowable, it is useful to comment on additional points of rejection raised by Examiner for said dependent claims.

Regarding claim 2, Watanabe does not contemplate the form of archived IP nor the interest in amending the archive IP. In addition, regarding claim 21, dependent on claim 2, Wilkinson does not contemplate assessing an archival fee for establishing an endowment trust.

Regarding claim 10, Watanabe does not contemplate the type of IP, and thus not the assemblage of information taken from an aspects list.

Regarding claim 11, Watanabe does not contemplate the selection of a level for access in combination with an access fee.

Regarding claim 13, Watanabe does not require a specific membership for access.

The remaining claims 19 – 32 all depend from claim 3 and thus cannot be anticipated or obvious over Watanabe in view of Wilkinson which has no consideration or contemplation of or permanent IP domains on the WWW. Applicant does not agree with the Examiner's assessment of the teachings of Watanabe and Wilkinson as they relate to Claims 22 – 32, and the teaching of Baba and Couchman as they relate to claim 9, but Applicant need not to as these claims rely on a claim which should now be in condition for allowance.

As a last specific note and more specifically regarding claim 31, Examiner has compare Wilkinson's use of 'index ... indices' at [0035] in which reads

SERIAL NO. 09/864,038

13

Atty Docket: 2157-001 (old)

in part "... constructing (gathering data and computing) an IP index or indices composed of individual IP assets, IP-impacted securities, or entities holding IP assets for the purpose of investment, comparison, and performance evaluation purposes. In this way, financial instruments related to IP assets or entities holding IP assets may be tracked against the performance of other IP assets or entities holding IP assets. The index may be used as a basis to compare investments, select investments, or a combination thereof."

In contradistinction, at page 8, lines 9-14 [0024] Applicant states "Each IP is archived under a unique Permanent IP Address (PIPA) and has an essential index tag attached to it. This tag will contain information including, but is not limited to: IP type, country of publication ... "; and at page 14, lines 28-29 [0052] Applicant further states "The additional information from the 'index tags' will further enhance the efficiency of searches for relevant on the I/WWW. At the same time, the Permanent IP Domain will be much larger, more open and inclusive than the various private commercial reference databases now available."

In summary, Wilkinson's 'index ... indices' pertain to 'numeric values' serving as composite indicators of values of underlying IP assets, analogous to Dow Jones Industrial Index(DJIX), the NASDAQ index and the FTSE index for the respective Stock Exchange. These indices are clearly unrelated to, and distinct from Applicant's 'index tags' and 'indexi tags' that contain metadata describing the archived IP to facilitate retrieval. The mere fact that the word 'index' is used in both cases is no basis for prior art rejection.

In view of the foregoing remarks, reconsideration and allowance of claims 3, 2 9-13 and new claims 19 - 32 is respectfully requested.

If there are any outstanding issues that can be dealt with in a teleconference, this agent invites such a teleconference with the Examiner. This agent can be contacted at (403) 203-0107 (Mountain Standard Time, - 2 hours).

Respectfully submitted,

Date: Feb 22/05


Sean W. Goodwin #39,568
Agent for the Applicant

Goodwin McKay
Suite 360, 237-8th Ave. S.E.
Calgary, AB T2G 5C3
CANADA
Ph. (403) 203-0107
Fx. (403) 203-0403

Via Facsimile To TC 2100 (BEFORE FINAL) to 703-872-9306

SERIAL NO. 09/864,038

14

Atty Docket: 2157-001 (old)